

REMARKS

Favorable review is requested in view of the above amendments and following remarks. Claims 1, 5, and 31 - 36 have been cancelled without prejudice. Claim 37 has been added and is supported, for example, at page 8, line 21 - page 9, line 18 and page 13, lines 6 - 10 of the specification. Minor editorial amendments have been made to claims 2, 3, 6 - 10, 18 - 23, and 26 - 30. No new matter has been added. Claims 2 - 4, 6 - 30, and 37 are pending in the application.

Election/Restriction

Applicants have cancelled without prejudice claims 31 - 36 directed to the non-elected method claims. Claims 27 - 29 have not been cancelled so that they may be reinstated upon the allowance of generic claim 1.

Drawings

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) for not including reference numerals 4, 5, and 6, which were mentioned in the specification. The discussion in the specification related to these reference numerals has been removed. Thus, withdrawal of the objection is requested.

Claim Objections

Claim 3 was objected to because of an informality. "said" was removed from claim 3. Withdrawal of the objection is requested.

Claims 18 and 22 were objected to because of an informality. Page 41, lines 13 - 14 of the specification provide that the surface hardness was measured in conformity with JIS S 6050, which is the Japanese standard. A copy of the document along with the English translation is enclosed for the Examiner's convenience. JIS S 6050 describes that the surface hardness is measured as a scale value, which is dimensionless. Withdrawal of the objection is requested.

Claim 19 and 22 were objected to because of an informality. The parentheses surrounding "kgf" have been removed. Withdrawal of the objections is requested.

Claims 21 and 22 were objected to because of an informality. "rate of abrasion" has been replaced with "wear rate". Withdrawal of the objection is requested.

Rejection under 35 U.S.C. § 112

Claims 1 - 26 and 30 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

Claim 1 has been cancelled, and claim 37 does not suffer from any of the alleged deficiencies of claim 1. The antecedent basis problems related to claims 6 and 10 have been alleviated.

Claim 2 and 14 - 22 were rejected for setting forth physical characteristics desired in an article and for not setting forth specific compositions, which would meet such characteristics. Legal precedent provides that there is nothing wrong with defining an article using physical characteristics or functional language. See In re Echard, 176 U.S.P.Q. 321, 322 (C.C.P.A. 1973) ("There is nothing intrinsically wrong in defining something by what it does rather than by what it is."). Therefore, it is legally incorrect to declare a claim is too broad and indefinite because the article is described using physical characteristics.

Claim 26 has been amended to properly claim an eraser in combination with a member. Thus, withdrawal of the rejection is requested.

Rejection under 35 U.S.C. § 101

Claim 26 was rejected under 35 U.S.C. § 101 because of an improper definition of a process. Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

Claim 26 has been amended to properly claim an eraser in combination with a member. Thus, withdrawal of the rejection is requested.

Rejection under 35 U.S.C. §§ 102 and 103

Claims 1 - 5, 7 - 11, and 14 - 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by or in the alternative, under 35 U.S.C. § 103(a) as obvious over Imashiro et al. (U.S. Patent No. 5,413,853). Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

A proper rejection under 35 U.S.C. § 103 requires consideration of two factors:

(1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition . . . ; and (2) whether the prior art would also have revealed that in so making . . . , those of ordinary skill in the art would have a reasonable expectation of success.

See In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). This motivation or suggestion also extends to obvious rejections based on a single prior art reference. See In re Kotzab, 55 U.S.P.Q.2d 1313, 1316 - 17 (Fed. Cir. 2000). In addition, when comparing the factual differences between the prior art and the claimed invention, every portion of the claim must be included. See In re Duva, 156 U.S.P.Q. 90, 94 (C.C.P.A. 1967) ("every portion of the . . . claims must be considered in determining the invention as a whole in arriving at our decision as to obviousness required by a rejection under section 103").

Independent claim 37 is directed to an eraser requiring that a void portion is filled with an elastic material for erasing. Even though the term "eraser" is used in the preamble of the claim, the term is well-known and describes a known category of goods. Therefore, the preamble is a relevant part of claim 37 and is entitled to consideration in determining patentability. Imashiro et al. is directed to a melamine resin foam that can be used as a construction material, etc. for high flame retardancy. See column 4, lines 65 - 67 of Imashiro et al. There is no disclosure or suggestion that the construction material of Imashiro et al. would have a reasonable expectation of success as an eraser of claim 37. Withdrawal of the rejection is requested.

Claims 1 - 5, 7 - 11, and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by or in the alternative, under 35 U.S.C. § 103(a) as obvious over Noboru (JP 08-258493). Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

Independent claim 37 is directed at an eraser requiring a skeleton portion on an abrasion surface of the elastic material that is broken from the eraser by a deformation force. JP 08-258493 does not disclose or suggest a skeleton portion on an abrasion surface of the elastic material that is broken from the eraser by a deformation force. In contrast, the porous material of JP 08-258493 wears off as the eraser is rubbed. Therefore, the claimed invention allows more of the rubbing force exerted while erasing to be used for actual erasing with the elastic material as opposed to also being used to wear down the porous material. See page 3 of the specification. Withdrawal of the rejection is requested.

Claims 6 and 14 - 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Noboru (above). Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

Claims 6 and 14 - 22 depend from claim 37. Noboru is distinguished above as failing to describe or suggest a skeleton portion on an abrasion surface of the elastic material that is broken from the eraser by a deformation force. Thus, withdrawal of the rejection is requested.

Claims 26 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sturzenegger (U.S. Patent No. 2,487,903) in view of Noboru (above). Applicants respectfully traverse this rejection, and respectfully request reconsideration in view of the following comments.

Claims 26 and 30 depend from claim 37. Noboru is distinguished above as failing to describe or suggest a skeleton portion on an abrasion surface of the elastic material that is broken from the eraser by a deformation force. Sturzenegger is directed to a motor-driven adjustable eraser. Even if it does, which is not being conceded, this reference fails to remedy the noted shortcoming of the Noboru. Thus, withdrawal of the rejection is requested.

Conclusion

In view of the amendments and comments presented herein, favorable reconsideration in the form of a Notice of Allowance is respectfully requested. If any further question should arise, the Examiner is invited to contact Applicants' representative at the number listed below.

Respectfully submitted,

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